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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,394	09/11/2003	Eiji Aida	09868/000M894-US0	6924
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DARBY & DARBY P.C. P. O. BOX 5257 NEW YORK, NY 10150-5257			HOEL, MATTHEW D	
			ART UNIT	PAPER NUMBER

3713

DATE MAILED: 06/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/660,394

Applicant(s)

AIDA, EIJI

Examiner

Matthew D. Hoel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 09/11/03, 08/01/05, 3-17-06
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1 to 5, 9 to 12, 17 to 19, and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Osawa (U.S. patent 6,699,122 B1).
3. As to Claim 1: '122 teaches a game machine comprising a display module with a plurality of display regions therein, when a game starts, a plurality of types of symbols that were statically displayed in the display regions are changingly displayed and the symbols that are changingly displayed are again statically displayed in the display regions (slot machine with variable display device comprising a set of reels, Abst., Figs. 7, 8). '122 has a recording module recording information about a position of on of the display regions in the display module in which a predetermined symbol is statically displayed, each time the predetermined symbol is statically displayed in one of the regions of the display module, while the symbols are alternately changingly displayed and statically displayed (winning symbol combination table in ROM 22, Col. 6, Lines 43 to 49). '122 has an evaluation module evaluating whether a fixed relationship is formed

in a position history of the predetermined symbol based on the recorded position information (prize paid out on winning combination in primary game, ST6 and ST8, Fig. 4).

4. As to Claim 2: '122 awards the player a prize if the position history contains the fixed relationship (prize paid out on winning combination in primary game, ST6 and ST8, Fig. 4).

5. As to Claim 3: The gaming machine of '122 further comprises a dependent display module comprising a plurality of dependent display regions arranged in a one-to-one correspondence with the display regions of the display module, wherein the dependent display module displays the predetermined symbol position history based on the recorded position information on the dependent display regions corresponding to the display regions on which the predetermined symbol was displayed statically (winning dollar symbol "\$" cumulatively displayed in secondary region every time it appears on the reels, Figs. 8-10, position in secondary region corresponds to position on reels).

6. As to Claim 4: Each of the dependent display regions of '122 is formed as a polygon (in this case a square, Figs. 8 to 10), and the player is awarded a prize if the plurality of the dependent display regions displaying the predetermined symbol position history are adjacent to each other, each of the polygons being separated by a polygonal side of the adjacent polygons (possible winning combinations for secondary region, Fig. 11, player wins prize in secondary game, Col. 8, Lines 37 to 64).

7. As to Claim 5: In the preferred embodiment of '122, the variable display comprises mechanical slot reels and the secondary display comprises an LCD (Fig. 3;

Col. 4, Lines 35 to 37; Col. 5, Lines 9 to 22). In an alternative embodiment, the primary display can be an LCD like the secondary display (Col. 5, Lines 1 to 4). In this alternative embodiment, each of the display regions would be formed as a polygon (like the secondary display, Figs. 7 to 10) and the player would be awarded a prize if the plurality of the display regions displaying at least one type of the symbol in the display module are adjacent to each other and are separated by a polygonal side of the adjacent polygons.

8. As to Claim 9: '122 teaches a computer-readable medium encoded with processing instructions for implementing a method of providing a game. '122 changingly displays a plurality of types of symbols that were statically displayed in a plurality of display regions in a display module, into different types of symbols when a game starting condition is established (slot machine with variable display device comprising a set of reels, Abst., Figs. 7, 8). '122 restores to a static display wherein the symbols in the display regions are displayed in the changed state (Figs. 7, 8). '122 records information about a position of one of the display regions in the display module in which a predetermined symbol is statically displayed, each time the predetermined symbol is statically displayed in one of the display regions of the display module, while the changing display operation and the static display operation are repeated (winning symbol combination table in ROM 22, Col. 6, Lines 43 to 49). '122 evaluates whether a position history of the predetermined symbol based on the recorded position information contains a fixed relationship (prize paid out on winning combination in primary game, ST6 and ST8, Fig. 4).

9. As to Claim 10: '122 further executes a dependent display operation for displaying the predetermined symbol position history based on the recorded position information in a plurality of dependent display regions arranged in a one-to-one correspondence with the display regions (Figs. 8 to 10), the dependent display regions being in a dependent display module disposed at a position different from the display module (secondary display at a different location than the primary display, Fig. 8).

10. As to Claim 11: '122 comprises a dependent display module comprising a plurality of dependent display regions arranged in a one-to-one correspondence with the display regions of the display module, wherein the dependent display module displays the predetermined symbol position history based on the recorded position information on the dependent display regions corresponding to the display regions on which the predetermined symbol was displayed statically (Fig. 13, Col. 11, Lines 42 to 53).

11. As to Claim 12: Each of the dependent display regions of '122 is formed as a polygon (Figs. 8 to 10) and the player is awarded a prize if the plurality of the display regions displaying at least one type of the symbol in the display module are adjacent to each other and are separated by a polygonal side of the adjacent polygons (possible winning combinations for secondary region, Fig. 11, player wins prize in secondary game, Col. 8, Lines 37 to 64).

12. As to Claim 17: '122 teaches a method of providing a game comprising statically displaying a plurality of types of symbols that were changingly displayed on a display module with a plurality of display regions when a game starts. '122 statically displays again the symbols that were changingly displayed in the display regions (Figs. 7 to 10).

'122 records information about a symbol of one of the display regions in the display module in which a predetermined symbol is statically displayed, each time the predetermined symbol is statically displayed in one of the displayed regions of the displayed module, while the symbols are alternately changingly displayed and then statically displayed (winning symbol combination table in ROM 22, Col. 6, Lines 43 to 49). '122 evaluates whether a fixed relationship is formed in a position history of the predetermined symbol based on the recorded position information (prize paid out on winning combination in primary game, ST6 and ST8, Fig. 4).

13. As to Claim 18: '122 awards a prize to a player if the position history contains the fixed relationship (prize paid out on winning combination in primary game, ST6 and ST8, Fig. 4).

14. As to Claim 19: '122 displays in a dependent display module the predetermined symbol position history based on the recorded position information on a plurality of dependent display regions arranged on the dependent the dependent display module in a one-to-one correspondence with the display regions of the display module, wherein the predetermined symbol position history is based on the recorded position information on the dependent display positions corresponding to the display regions on which the predetermined symbol was displayed statically (Figs. 7 to 10).

15. As to Claim 20: '122 forms each of the display regions as a polygon, and awards a prize to the player if the plurality of the display regions displaying the predetermined symbol history are adjacent to each other, each of the polygons being separated by a polygonal side of the adjacent polygons (Figs. 7 to 10). In the preferred embodiment of

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'122, the variable display comprises mechanical slot reels and the secondary display comprises an LCD (Fig. 3; Col. 4, Lines 35 to 37; Col. 5, Lines 9 to 22). In an alternative embodiment, the primary display can be an LCD like the secondary display (Col. 5, Lines 1 to 4). In this alternative embodiment, each of the display regions would be formed as a polygon (like the secondary display, Figs. 7 to 10) and the player would be awarded a prize if the plurality of the display regions displaying at least one type of the symbol in the display module are adjacent to each other and are separated by a polygonal side of the adjacent polygons.

16. As to Claim 21: '122 forms each of the dependent display regions as a polygon (Figs. 7 to 10). '122 awards a prize to a player if the plurality of the display regions displaying at least one type of the symbol in the display module are adjacent to each other and are separated by a polygonal side of the adjacent polygons (possible winning combinations for secondary region, Fig. 11, player wins prize in secondary game, Col. 8, Lines 37 to 64).

### ***Claim Rejections - 35 USC § 103***

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.



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18. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

19. Claims 6 to 8, 13 to 16, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over '122 in view of Todd (UK patent GB 2 350 715 A).

20. As to Claim 6: '122 discloses all of the elements of Claim 6, but lacks specificity as to a plurality of game machines and a shared display module comprising a plurality of display regions. '122 teaches a game machine comprising a display module with a plurality of display regions wherein, when a game starts, a plurality of types of symbols that were statically displayed in the display regions are changingly displayed and the symbols that are changingly displayed are again statically displayed in the display regions (slot machine with variable display device comprising a set of reels, Abst., Figs. 7, 8). The game machine of '122 further comprises a recording module recording information about a position of one of the display regions in the display module in which a predetermined symbol is statically displayed, each time the predetermined symbol is statically displayed in one of the regions of the display module, while the symbols are alternately changingly displayed and then statically displayed (winning symbol combination table in ROM 22, Col. 6, Lines 43 to 49). The game machine of '122 comprises an evaluation module evaluating whether a fixed relationship is formed in a

position history of the predetermined symbol based on the recorded position information (prize paid out on winning combination in primary game, ST6 and ST8, Fig. 4). '122 teaches a second display module comprising a plurality of display regions arranged in a one-to-one correspondence with the first display module of the game machine and displaying the position history of a predetermined symbol based on information recorded by the game machine on the second display regions corresponding to the first display regions at which the predetermined symbol was statically displayed (Figs. 7 to 10). '715, however, teaches a plurality of gaming machines (Abst.). '715 also teaches a shared display module (Abst., Figs. 1, 2). The game feature may supply a supplementary game (Page 3, Lines 18 to 22). The game feature of the common display may be a similar game to the primary game played on the individual machines (Page 4, Line 9 to Page 5, Line 2). The awards on the common display may be displayed in the same order as the awards in the individual machines (Page 9, Lines 17 to 22). '715 teaches the game machines and the shared display module being connected by way of network communications (Figs. 1, 2). It would be obvious to one of ordinary skill in the art to apply the networked common display and plural game machines of '715 to the game machine of '122. '715 is meant to be used with slot machines (Page 6, Lines 1 to 17). The combination would have a plurality of game machines, each of which has the characteristics of the game machine of '122, and a shared display module comprising a plurality of shared display regions arranged in a one-to-one correspondence with the display regions of the display modules of the game machines and displaying the position history of the predetermined symbol based on the

position information recorded by the game machines on the shared display regions corresponding to the display regions at which the predetermined symbol was statically displayed. The advantage of this combination would be to enhance players' interest in the game by displaying an enhanced win opportunity similar to the win opportunity in the base game ('715, Abst.).

21. As to Claim 7: '715 teaches a shared display region (Abst., Figs. 1, 2). '122 teaches an prize being awarded if a set of second display regions displays a predetermined symbol position history being positioned on a predetermined alignment line (Fig. 13).

22. As to Claim 8: '715 teaches a shared display region (Abst., Figs. 1, 2). '122 teaches display regions in a display module and shared regions in a second display module being formed as polygons (Figs. 7 to 10). In the preferred embodiment of '122, the variable display comprises mechanical slot reels and the secondary display comprises an LCD (Fig. 3; Col. 4, Lines 35 to 37; Col. 5, Lines 9 to 22). In an alternative embodiment, the primary display can be an LCD like the secondary display (Col. 5, Lines 1 to 4). In this alternative embodiment, each of the display regions would be formed as a polygon (like the secondary display, Figs. 7 to 10) and the player would be awarded a prize if the plurality of the display regions displaying at least one type of the symbol in the display module are adjacent to each other and are separated by a polygonal side of the adjacent polygons.

23. As to Claim 13: '122 teaches the player of the game system being awarded a prize if the position history contains the fixed relationship (Figs. 13, 15).

24. As to Claim 14: '122 teaches a dependent display module comprising a plurality of dependent display regions arranged in a one-to-one correspondence with the display regions of the display module, wherein the dependent display module displays the predetermined symbol position history based on the recorded position information on the dependent display regions corresponding to the display regions on which the predetermined symbol was displayed statically (Fig. 13; Col. 11, Lines 42 to 53).

25. As to Claim 15: '122 teaches each of the dependent display regions being formed as a polygon and the player being awarded a prize if the plurality of display regions displaying the predetermined symbol position history are adjacent to each other, each of the polygons being separated by a polygonal side of the adjacent polygons (Figs. 13 to 15).

26. As to Claim 16: '122 teaches each of the dependent display regions being formed as a polygon, and the player being awarded a prize if the plurality of the display regions displaying at least one type of symbol in the display module are adjacent to each other and are separated by a polygonal side of the adjacent polygons (Figs. 13 to 15).

27. As to Claim 22: '715 teaches connecting game machines to a shared display module by means of network communications (Abst., Figs. 1, 2). '122 teaches a second display module comprising a plurality of display regions arranged in a one-to-one correspondence with the display regions of the display module of the game machine and displaying the position history of the predetermined symbol based on position information recorded by the game machine on the second display regions

corresponding to the display regions at which the predetermined symbol was statically displayed (Figs. 7 to 10).

***Claim Rejections - 35 USC § 112***

28. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

29. Claims 15 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims cite the limitation "dependent display regions" with no antecedent basis. These claims depend from independent Claim 6, which does not mention "dependent display regions." The examiner believes the applicant intends for Claims 15 and 16 to depend from Claim 14, which mentions "dependent display regions" and depends from Claim 6.

***Citation of Pertinent Prior Art***

30. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Osawa in U.S. patent 6,857,958 B2 discloses a bonus game similar to that of '122.

**Conclusion**

31. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew D. Hoel whose telephone number is (571) 272-5961. The examiner can normally be reached on Mon. to Fri., 8:00 A.M. to 4:30 P.M.

32. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan M. Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

33. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Matthew D. Hoel, Patent Examiner  
AU 3713



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**SUPERVISORY PATENT EXAMINER**

TC3700